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Patent #22

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Patent Application of:)
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Shah-Nazaroff et al.)
)
Serial No.: 09/183,282)
)
Filed: October 30, 1998)
)
For: METHOD AND APPARATUS FOR SEARCHING)
THROUGH AN ELECTRONIC PROGRAMMING)
GUIDE)
)
)
)
)

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FEB 13 2003
GROUP 3600
Art Unit: 2172
Examiner: Colbert, E.

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

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Technology Center 2100

REPLY IN RESPONSE TO EXAMINER'S ANSWER
OF DECEMBER 6th, 2002
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Sir:

Applicants (hereafter "Appellant") hereby submits this Reply in triplicate in support of its appeal from a final decision by the Examiner, mailed May 6, 2002 in the above-captioned case. Appellant respectfully requests consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the above-captioned patent application.

An oral hearing is not desired.

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(37 C.F.R. § 1.8 (a))

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On January 31, 2003
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April Worley
Name of Person Mailing Correspondence

Shirley A. Worley
Signature
7/31/03

Docket No. 042390.P6489
Application No. 09/183,282

I. Sections 1-10 and 12

Appellant makes no reply to Sections 1-10 and 12 of the Examiner's Answer.

Section 10 appears to be an exact duplicate of the substance of the Office action of May 6, 2002.

II. Objection under Section 132

In answer, the Examiner states (page 12, 1st para. et seq.) merely, "[t]his is not interpreted by the Examiner as suggesting or disclosing" the recitations added by the amendment filed on 04/03/02. Such an answer provides little assistance in understanding the Examiner's position.

As can be seen from the portions of the application quoted in Appellant's Brief, the application states that when a selectable identifier is selected, the query interface performs instructions stored in the data portion of the entertainment system data (page 15, lines 3-6). This corresponds to the claim language of e.g. Claim 1, "receiving a selection of the selectable identifier; accessing instructions linked to the selectable identifier."

As can also be seen from the quoted sections, the instructions to be executed by the query interface may include instructions for the query interface to perform a search in the database (page 13, lines 16-22). This corresponds to the claim language of e.g. Claim 11, "the query interface... to execute instructions linked to the identifier that require a search to be performed in the data engine."

III. Obviousness Rejections

A. Summary

Appellants have carefully read through the Examiner's Answer in an effort to determine the core basis for the Examiner's refusal to allow the pending claims. The Examiner's Answer persistently refers to one modification of what is disclosed in the

references. The Examiner then asserts that this modification is obvious and that the claims, if read broadly, would be anticipated by this modification. This modification, while mentioned in the Final rejection of May 6, 2002, was not urged as aggressively. Appellants believe that the modification is not obvious from the references and that, even if it were, it would not affect the patentability of the claims.

1. The Modification

The modification is described as a "user can display program schedule information for any of the selected plurality of television programs in an overlaying relationship with a television program appearing on any one of the selected plurality of channels on the television." (page 13, lines 13 et seq.) This modification is based on Figure 4 of Dunn which shows, not program schedule information, but a browse interface for finding movie titles. In Dunn, the trailers (previews) for movies as well as the movies themselves are not played on a schedule but downloaded and played on demand. Dunn teaches that the four icon buttons of Figure 4 can be overlaid on a displayed video trailer [movie preview]. The Examiner has modified Dunn so that the viewer is watching scheduled television shows, not movies on demand, and so that the browse interface is program schedule information, not a list browsing tool.

There is nothing in Dunn nor in Williams to suggest such a modification. The Examiner has provided no other basis for the modification except for generally available knowledge. Appellants respectfully submit that some current digital television receivers allow the viewer to view the electronic program guide overlaid on broadcast television shows and that the modification created by the Examiner may be an inappropriate use of hindsight.

2. The Claimed Limitation

The disputed limitation as recited by e.g. Claim 1 has, inter alia, two parts (1) "presenting a selectable identifier corresponding to the first set of entertainment system data" [the first set of entertainment system data corresponding to a first entertainment selection] and (2) "performing a search based on the accessed instructions for a second entertainment selection having a corresponding set of entertainment system data related to the first set of entertainment system data when a selectable identifier is selected." So the claim has a first entertainment selection. There is data corresponding to the first selection and a selectable identifier associated with that data. The search is for a second selection that has data related to the data of the first selection.

3. The Modification as Applied Broadly to the Claimed Limitation

The Examiner suggests that the modification has two entertainment selections as defined in the claims, the TV show being watched and the TV show for which program schedule information is displayed. The Examiner does not draw a correspondence between the modification and the other elements recited in the claims.

While the program schedule information of the Examiner's modification is not described, Appellants will guess that it at least has some data about the second TV show, the TV show that is not being watched. There is no data about the first TV show other than the show itself. Reading, for example, Claim 1 broadly, the data corresponding to the first entertainment selection could be the actual first TV show, i.e. the images and sounds of that show. The data corresponding to the second entertainment selection could be the program schedule guide information. Claim 1, for example, further recites, "performing a search for a second entertainment selection..." The Examiner did not describe this aspect of the modification, however, in Dunn, there is a search, the search for titles associated with a star on the displayed list. This search results in the display of a title which might not relate to the trailer being watched.

Going back to Claim 1, the search finds an entertainment selection with a corresponding set of entertainment system data that is related to the first set of entertainment system data (for the first selection). In Dunn, there was no data for the first selection except the program itself. However the search in Dunn does not look at images and sounds of the first selection. The search in Dunn looks only at the selected actor. Thus the limitations of Claim 1 are not met.

The only way to achieve a result like that of the present invention using Dunn would be to figure out the name of the actor for the first selection (this might be available from the program guide but the Examiner doesn't say), then call up the list of actors in the browse interface and select the name of the actor located in the program guide. This will cause a search for other selections that feature the same actor. However, this analogy ignores many of the specific limitations of the claims on appeal. The claims on appeal feature a selectable identifier which causes all of this to be done automatically.

B. Obviousness in view of Dunn

The Examiner's Answer (page 12, 2d para. et seq.) reiterates the conclusion that claims 1-10, 15-23 and 26-33 are unpatentable over Dunn. The first reason provided is "because it is well known in the art for the combination of a user selecting the actor/actress and looking at the movies by the actor/actress, and the time to have the second selection by the same actor/actress displayed." "A user can display program schedule information for any of the selected plurality of television programs in an overlaying relationship with a television program appearing on any one of the selected plurality of channels on the television."

In Dunn, the user can select an actor and then, as a result of a search, a list of movies by the actor is displayed. This would seem to be what the Examiner is suggesting. The Examiner's statement "and the time to have the second selection by the same actor/actress displayed." is not understood. Dunn allows the user to make a second

selection from the actor list, but this is not a search as recited in the claims. This is just another selection from the same list from the first search. Dunn's Figure 5 shows the lists.

First, in Dunn only two things can be selected, a name, which invokes a database search, and a title, which invokes playing the trailer (preview) for the movie. So, the list of actors cannot be the selectable identifier because the actors do not correspond to any particular entertainment selection. When an actor name is selected, then a list of entertainment selections is presented, however, no search, as recited in Claim 1, is performed if a movie name is selected. The system simply fetches the corresponding trailer (preview).

The Examiner's next sentence is, "[a] user can display program schedule information for any of the selected plurality of television programs in an overlaying relationship with a television program appearing on any one of the selected plurality of channels on the television." First, if this is prior art, it is not described in Dunn. Second, it does not seem to have any bearing on the claim language quoted above.

The Examiner appears to reason from common knowledge the aspects of the present claims which are missing from Dunn (page 14, lines 1 et seq.). As support, the Examiner cites the search described in Dunn at Column 3, lines 16 et seq. This, however, is the same search discussed above and the only search performed in Dunn. The viewer selected particular criteria, described at Column 3, lines 2 et seq., correspond to the radio buttons of Fig. 4. This is, for example, the actor/actress name of the Examiner's previous example.

The Examiner at page 13, first paragraph is again referring to the process suggested by Figures 3 and 4 of Dunn. In Figure 4, the viewer selects the "STARS" radio button. The system retrieves all entries under that category. The viewer in Figure 5, then selects one of the stars in the list and the system searches for and retrieves all the titles corresponding to that actor. Upon selecting a title, the system retrieves a trailer or the

actual feature that corresponds to the selected title. The program ID, trailer ID, and trailer moniker (Col. 6, lines 11 et seq.) referred to by the Examiner are all pointers used by the Dunn system to retrieve data.

In short, the reference fails to show or suggest performing a search for a second entertainment selection having a corresponding set of entertainment system data related to a first set of entertainment system data when a selectable identifier corresponding to the first set of entertainment system data is selected. In Dunn, the actors on the list do not correspond to any particular selection. The titles, when selected, do not generate a search for a second selection. The convenience allowed for by the present invention is a significant improvement over Dunn, particularly in the context of an entertainment system with a small wireless remote.

Appellant respectfully submits that the Examiner's Answer does not overcome the shortcomings of the Final rejection from which this appeal is made.

C. Obviousness in view of Dunn and Williams

The Examiner's Answer appears to have three main points. First, the claims, interpreted broadly, do read on the art. Second, Appellant's argument relies on subject matter in the specification but not claimed, and third, that the Examiner's rejection of May 6, 2002 carefully and thoroughly provided a correspondence between each claim element and the prior art.

With respect to interpreting the claims broadly, the Examiner has acknowledged that Williams does not teach the selectable identifier as recited in the claims (page 9, lines 16 et seq.) The Examiner appears to construe the claims so broadly as to include displaying schedule information for one entertainment selection "in an overlaying relationship with" another entertainment selection (page 9, penultimate line et seq.).

Such a construction ignores the entire recitation of the selectable identifier. There is simply no such selectable identifier in Dunn nor in Williams. Claim 11, for example recites "the identifier being selectable to cause ... a search to be performed in the data engine and to display a second entertainment selection... having a corresponding second set of entertainment system data related to the first set of entertainment system data." There is no suggestion in either reference of selecting something that causes a search to find a second selection nor of the data for such two selections to be related. Reading these limitations out of the claims is not permissible in broadly interpreting claims.

As for arguing in terms of specific examples in the specification, Appellant simply fails to find where this is done in Appellant's Brief. However, the arguments presented above and in the Brief are believed to stand based on the words in the claims alone.

As for drawing up a correspondence between the claims and the art, the Examiner has indeed done so. While Appellant may not agree with each correspondence, Appellant does agree that the references do not show a selectable identifier as claimed. The Examiner supplies this missing element of the claims simply by asserting that "such a modification [of Williams] would allow a user to display program schedule information for any of the selected plurality of television programs in an overlaying relationship with a television program appearing on any one of the selected plurality of channels on the television." Even if the assertion were true, the Examiner provides no motivation from the references nor common knowledge in the art. However, it is not true. This modification created by the Examiner does not pertain to a selectable identifier and a search. It pertains to a program guide for one show displayed over a different show.

IV. CONCLUSION

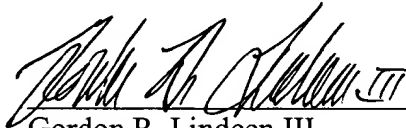
Appellant maintains that all the appealed claims in this application are patentable and requests again that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

This Reply is submitted in triplicate.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: 1/31/13



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